

#### **IV. REMARKS**

Claims 1-30 are pending in this application. Claims 17-30 are withdrawn from consideration. By this response, no claims have been amended. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Furthermore, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

##### **A. OBJECTION TO THE SPECIFICATION**

In the Office Action, the title of the invention is objected to for allegedly being “not descriptive.” Office Action, p. 2. In response, Applicant has amended the title to comply with the Office’s request. Accordingly, Applicant respectfully requests withdrawal of the objection.

##### **B. REJECTION OF THE CLAIMS UNDER 35 U.S.C. 102(b)**

In the Office Action, claims 1-9 and 12-16 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Tsuchiya et al. (U.S. Pat. No. 6,530,968), hereinafter “Tsuchiya.” In response, Applicant submits that the Office fails to show that Tsuchiya discloses each and every feature of the claimed invention. For example, with respect to claim 1, the Office fails to show that Tsuchiya discloses, *inter alia*, “applying a slurry that includes an additive for forming a polishing inhibiting layer in situ across the topography, the polishing inhibiting layer creating a polishing rate for the topography that is non-linear with polishing pressure.” Specifically, Applicant submits that Tsuchiya fails to disclose the formation of a polishing inhibiting layer

across the topography. Interpreting Tsuchiya only for the purposes of this response, Applicant submits that Tsuchiya merely discloses that “a thickener...must be a compound without an ionic group with an opposite sign to a charge on a polishing material grain surface.” Column 4, lines 40-42. Tsuchiya keeps the thickener suspended and active in the slurry to achieve an optimum slurry viscosity to delay polishing and dishing. However, Tsuchiya fails to explicitly disclose the formation of a polishing inhibiting layer. In contrast, in the present invention, the additive will be attracted towards the surface to be polished and will adhere to that surface due to electrostatic effects. Tsuchiya, however, fails to disclose this feature. Accordingly, Applicant respectfully requests withdrawal of the rejection.

In support of its rejection, the Office asserts that “the polishing inhibiting layer creat(es) a polishing rate for the topography that is inherently non-linear with polishing pressure.” Office Action, p. 3. In response, Applicants submit that inherency may not be established by probabilities or possibilities. *MEHL/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362 (Fed. Cir. 1999). The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.* The Office’s assertion based on inherency is not sufficient to make out a prima facie case of anticipation because the disclosure in Tsuchiya is insufficient to show that the natural result flowing from the operation as taught in Tsuchiya would result in creating a polishing rate for the topography that is non-linear with polishing pressure. Moreover, Applicants submit that the disclosure in Tsuchiya is insufficient to show that the natural result flowing from the operation as taught in Tsuchiya would result in forming a polishing inhibiting layer over the topography. In particular, the electrostatic charge of materials is explained with specificity relative to attraction of the thickener and the polishing material grain. However, no description is provided relative to attraction of the thickener and the surface being polished.

Only by making an assumption can the Office conclude that a polishing inhibiting layer would be formed. Further, no disclosure is provided relative to the polishing pressure. The Office cannot simply assume that the materials in Tsuchiya act as in the recited claims, especially where Tsuchiya discusses similar subject matter with specificity but is devoid of any teaching relative to the recitations. Accordingly, Applicants submit that neither the paragraphs cited by the Office, nor Tsuchiya as a whole explicitly or inherently disclose, *inter alia*, applying a slurry that includes an additive for forming a polishing inhibiting layer in situ across the topography, the polishing inhibiting layer creating a polishing rate for the topography that is non-linear with polishing pressure.

Still furthermore, with respect to claim 3, the Office fails to show that Tsuchiya discloses, *inter alia*, "...wherein the cationic surfactant includes a chemical structure selected from the group consisting of: a)  $[\text{CH}_3(\text{CH}_2)_x\text{N}(\text{R})]\text{M}$ , wherein M is selected from the group consisting of: Cl, Br and I, x equals an integer between 2 and 24, and the R includes three carbon-based functional groups, each having less than eight carbon atoms; and b)  $\text{C}_p\text{H}_q\text{QN}$ , where Q is selected from the group consisting of: Cl, Br and I, and  $p > 8$  and  $q > 20$ ." In support of its rejection with respect to claims 2-7, the Office asserts that "Tsuchiya discloses the additive to form the 'polishing inhibiting layer' include(ing) one of: an anionic surfactant (e.g. sodium (salt) sulfate and dodecyl sulfates) and a cationic surfactant (e.g. CTAB and cetylpyridinium chloride). Office Action, p. 2. However, Applicant submits that Tsuchiya fails to disclose, *inter alia*, all the formulaic limitations relating to cationic surfactants, as recited by claim 3. Interpreting Tsuchiya only for purposes of this response, Applicant submits that Tsuchiya discloses that,

"cationic surfactants include amine salts containing a salt-forming primary, secondary or tertiary amine and their modified salts; onium compounds such as quaternary ammonium, phosphonium and sulfonium salts; circular nitrogen-

containing compounds and heterocyclic compounds such as pyridinium, quinolinium and imidazolinium salts; for example, lauryl-trimethyl-ammonium chloride, cetyl-trimethyl-ammonium chloride (CTAC), cetyl-trimethyl-ammonium bromide (CTAB), cetyl-dimethyl-benzyl-ammonium bromide, cetylpyridinium chloride, dodecylpyridinium chloride, alkyl-dimethyl-chlorobenzyl-ammonium chloride and alkyl-naphthalene-pyridinium chloride.”

As listed in the above passage, Tsuchiya discloses, generally, a number of cationic surfactants.

However, Tsuchiya fails to disclose the specific formulaic limitation(s) recited by claim 3.

Accordingly, Applicant submits that Tsuchiya fails to disclose each and every element of claim 3.

#### **B. REJECTION OF CLAIMS UNDER 35 U.S.C. 103(a)**

In the Office Action, claims 10-11 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Tsuchiya. Applicant herein incorporates the arguments presented above with respect to the corresponding independent claims, from which each of the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own.

Applicant submits that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicant does not acquiesce to the Office’s interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicant does not acquiesce to the Office’s combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office’s combinations and modifications have not been separately addressed herein for brevity. However, Applicant reserves the right to present such arguments in a later response should one be necessary.

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

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Reg. No.: 57,878

Date: January 10, 2007

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